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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,735	08/09/2000	Nizar Alibhoy	22925-701-3-US	5911

7590 12/20/2002

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EXAMINER

LE, DAVID Q

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/635,735

Applicant(s)

ALLIBHOY ET AL

Examiner

David Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

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## DETAILED ACTION

### *Examiner's Note*

1. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1, 5, 26** are rejected under 35 U.S.C. 102(b) as being anticipated by Ginter et al., US Patent No. 5,892,900.

As per **claim 1**:

Ginter discloses a "Virtual Distribution Environment" ("VDE") that comprises

*a method of controlling a transaction (Cols 3-6: "VDE Control Capabilities") between a receiver (Ginter's "VDE content user/consumer") and a content provider (Ginter's "VDE content creator/author/publisher/repository"), occurring over a network operated by a network operator (Ginter's "Information Utility/Rights Distributor"), wherein said content provider offers enhanced content programming relating to the transaction (Abstract, Figs 1, 1A, 2, 2A, 77, 78, 87; associated text), the method comprising the steps of:*

*storing a receiver profile (Ginter's "user profile") in a data base controlled by a third party (Ginter's "Information Utility/Rights Distributor"), wherein said third party is coupled to said network (Figs 2, 78, associated text; Col 55, lines 53-56);*

*intercepting a user request for the enhanced content programming, said user request originating in the receiver, wherein said intercepting step is performed by said third party (Figs 2, 77, associated text);*

*determining if said user request for the enhanced content programming is authorized by said stored receiver profile (Fig 78, associated text; Col 55, lines 53-56); and*

*permitting the enhanced content programming to be provided to the receiver in response to the user request if the content provider is authorized by said user profile, wherein said permitting step is performed by said third party (Figs 2, 2A, 77, 78, associated text).*

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As per claim 5:

Ginter further discloses

*a method of augmenting (Cols 285-287: "Modifying Object Content") a network transaction between a user receiver and a content provider, the method comprising the steps of:*

*storing a user profile in a data base controlled by a third party (Fig 78, associated text; Col 55, lines 53-56);*

*receiving enhanced content programming from the content provider within the user receiver (Figs 2, 2A, 77, 78, associated text);*

*detecting a trigger within said enhanced content programming (Col 42, lines 17-34, 35-36, rest of paragraph; Col 177, lines 17-46), said recognizing step performed by said third party;*

*intercepting a user request directed at the content provider by the user receiver, said intercepting step performed by said third party (Figs 2, 77, associated text);*

*appending additional parameters to said user request (Cols 285-287: "Modifying Object Content");*

*directing said appended user request to the content provider (Figs 2, 77, 78, associated text) ;*

*intercepting a user request response directed at the user receiver by the content provider, wherein said user request response comprises at least a portion of the network transaction (Figs 2, 77, 78, associated text);*

*forwarding said user request response to the user receiver (Figs 2, 77, 78, associated text);*

*intercepting a user purchase request directed at the content provider by the user receiver, said intercepting step performed by said third party (Figs 2, 77, 78, associated text) ;*

*extracting user purchasing information from said user profile stored in said third party controlled data base; and providing said extracted user purchasing information to said content provider by said third party (Col 24, lines 24-53; Col 35, lines 13-53).*

As per claim 26:

Ginter discloses (per above citations):

*a network-based system for supporting a user transaction, the system comprising:*

*a network;*

*a content provider coupled to said network, wherein said content provider supplies enhanced content programming relating to the user transaction;*

*a receiver coupled to said network, said receiver capable of receiving said enhanced content programming and interacting with said content provider via said network;*

*third party means for intercepting data relating to the user transaction flowing between said content provider and said receiver via said network;*

Ginter further discloses:

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*third party means for directly obtaining supplemental information from said content provider relating to the financial transaction (Col 24, lines 24-53; Col 35, lines 13-53);*

*a data base coupled to said network and controlled by a third party, said data base storing a user profile associated with said receiver and at least a portion of said intercepted data and said supplemental information (Fig 78, associated text);*

*third party means for selecting a portion of said stored data and supplemental information to be displayed (Col 36, lines 10-43);*

*a display coupled to said receiver for displaying said selected portion of said stored data and supplemental information (Fig 7, associated text; Col 107, lines 1-28; Col 262, "User Notification Exception Interface"); and*

*third party means for finalizing the user transaction with said receiver and said content provider, wherein said third party means for finalizing the user transaction further comprises the third party means for providing at least a portion of said stored user profile to said content provider (Col 36, lines 10-43).*

4. **Claims 2-4, 6-13, 19-21, 27-29, 33-34** are rejected under 35 U.S.C. 102(b) as being anticipated by Ginter.

As per **claim 2**:

Ginter discloses all the limitations of claim 1.

Ginter further discloses the steps of:

*determining if said user request for the enhanced content programming is unauthorized by said stored receiver profile (Cols 3-6: "VDE Control Capabilities"; Col 24, lines 9-54; Col 294, lines 11-49); and*

*preventing the enhanced content programming to be provided to the receiver in response to the user request if the content provider is unauthorized by said user profile, wherein said preventing step is performed by said third party (Fig 78: "User/Author Registration", associated text).*

As per **claim 3**:

Ginter discloses all the limitations of claim 1.

Ginter further discloses the steps of:

*determining if said user request for the enhanced content programming is unauthorized by said stored receiver profile (Col 24, lines 9-54; Col 294, lines 11-49); and*

*permitting the enhanced content programming to be provided to the receiver in response to the user request if the content provider is not unauthorized by said user profile, wherein said permitting step is performed by said third party (Fig 78: "User/Author Registration", associated text).*

As per **claim 4**:

Ginter discloses all the limitations of claim 1.

Ginter further discloses (Col 293, "Account Numbers and User Ids") that:

*receiver profile is comprised of multiple user profiles, wherein each user profile includes a user identifier, wherein said*

*determining step is further comprised of the steps of*

*requesting said user identifier from said receiver;*

*receiving said user identifier by said third party,*

*determining if said user profile associated with said received user identifier authorizes receipt of the enhanced content programming; and*

*permitting the enhanced content programming to be provided to the receiver in response to the user request only if said user profile associated with said received user identifier authorizes the enhanced content programming.*

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As per **claim 6**:

Ginter discloses all the limitations of claim 5.

Ginter further discloses (Fig 72B, associated text):

*extracting transaction information from said intercepted user request response; and displaying at least a portion of said extracted transaction information on a display coupled to the user receiver.*

As per **claim 7**:

Ginter discloses all the limitations of claim 6.

Ginter further discloses

*further comprising the step of displaying at least one advertisement simultaneously with said portion of said extracted transaction information (Col 286, lines 39-41).*

As per **claim 8**:

Ginter discloses all the limitations of claim 7.

Ginter further discloses that

*at least one advertisement includes linking information to a specific content provider (Col 109, lines 43-57; Col 314, lines 1-15).*

As per **claim 9**:

Ginter discloses all the limitations of claim 5.

Ginter further discloses (Fig 78, associated text):

*further comprising the steps of determining if said user request is authorized by said stored user profile; and*

*directing said appended user request to the content provider if said user request is authorized by said user profile.*

As per **claim 10**:

Ginter discloses all the limitations of claim 5.

Ginter further discloses (Figs 1A, 2, 77, 78, associated text):

*appending an address to a third party controller (Ginter's "Rights Distributor/Clearinghouse/Administrator") to said intercepted user request; and*

*directing said intercepted user request to said third party controller, wherein said third party controller performs said step of appending additional parameters to said user request.*

As per **claim 11**:

Ginter discloses all the limitations of claim 5.

Ginter further discloses (Cols 285-286: "Modifying Object Content"):

*the step of appending a marker to said user request response by the content provider, wherein said third party uses said marker to intercept said user request response.*

As per **claim 12**:

Ginter discloses all the limitations of claim 5.

Ginter further discloses (Col 36, lines 10-43; Figs 2, 3, 4, 5A-B, 78, associated text) that

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*user profile is comprised of information selected from the group consisting of shipping information and billing information.*

As per **claim 13**:

Ginter discloses all the limitations of claim 5.

Ginter further discloses (Col 36, lines 10-43; Figs 2, 3, 4, 5A-B, 45-48, 78, associated text) that *said user profile is comprised of a user budget, wherein said method further comprises the steps of extracting said user budget from said user profile stored in said third party controlled data base; determining if said user budget permits said user purchase request; and providing said extracted user purchasing information to the content provider only if permitted by said user budget.*

As per **claim 19**:

Ginter discloses all the limitations of claim 5.

Ginter further discloses (Fig 78, associated text)

*the steps of entering said user purchase request into said third party controlled data base.*

As per **claim 20**.

Ginter discloses all the limitations of claim 5.

Ginter further discloses (Col 308, lines 1-24, Fig 78, associated text) the steps of *directing a request for updated information pertaining to said user request to the content provider, wherein said directing step is performed by said third party; receiving said updated information from said content provider by said third party; and storing said updated information in said third party controlled data base.*

As per **claim 21**.

Ginter discloses all the limitations of claim 5.

Ginter further discloses (Figs 72C-D, associated text)

*the step of obtaining supplemental information from the user receiver by said third party in order to complete said user purchase request.*

As per **claim 27**:

Ginter discloses all the limitations of claim 26.

Ginter further discloses (Col 42, lines 17-34, 35-36, rest of paragraph; Col 177, lines 17-46) *said third party intercepting means detects triggers within said enhanced content programming.*

As per **claim 28**:

Ginter discloses all the limitations of claim 26.

Ginter further discloses (Figs 1, 7-8, associated text; Col 33, line 66 – Col 35, line 12; Col 62-63, "Electronic Appliance") *said receiver is selected from the group consisting of set-top boxes, telephones, PDAs, and computers.*

As per **claim 29**:

Ginter discloses all the limitations of claim 26.

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Ginter further discloses (Figs 1, 7-8, associated text; Col 33, line 66 – Col 35, line 12; Col 62-63, "Electronic Appliance") that  
*network is selected from the group consisting of cable, fiber optics, telephone lines, terrestrial broadcast systems, and satellite broadcast systems.*

As per **claim 33**:

Ginter discloses all the limitations of claim 26.

Ginter further discloses (Figs 1A, 2, 77, 78, associated text)

*said third party intercepting means, said third party means for directly obtaining supplemental information, said third party selecting means, said third party finalizing means, and said third party means for providing said portion of said stored user profile to said content provider is a third party controller (Ginter's "Rights Distributor/Clearinghouse/Administrator") coupled to said content provider and to said receiver via said network.*

As per **claim 34**:

Ginter discloses all the limitations of claim 26.

Ginter further discloses (Col 285-286, "Modifying Object Content")

*third party means for displaying at least one advertisement on said display, said at least one advertisement displayed simultaneously with said selected portion of said stored data and supplemental information.*

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 14-18, 22-25, 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ginter*.

As per **claims 14-18**:

Ginter discloses all the limitations of claim 5.

Ginter does not specifically disclose the steps recited in claims 14-18.

However, Ginter teaches (Fig 78, associated text; Col 309, line 56 – Col 311, line 8) that in order for content providers/authors to make their products available to users via the network they would need to register with the network operator/rights distributor/information utility (Applicant's "network operator"), enter into detailed agreements with the network operator about the rules governing the distribution, use, and payment for those products. Similarly, Ginter teaches (see previous citations above) that potential users of such products also need to establish accounts and profiles with the network operator, so that they may be unambiguously authorized to access and use the products. Lastly Ginter teaches (Fig 78, associated text) that multiple content repositories/authors/publishers can be built into the network, so as to provide a flexible, dynamic, and rich content resource for potential users. Overall, Ginter's invention



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provides a very fine-grained method for controlling the flow, delivery, access, and payment for all types of electronic content over a network.

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to use Ginter's teachings and configure a distribution network with the limitations of claims 14-18. Such a system would maximize user participation while providing the network operator with strong control over content providers/publishers. Should a content provider become un-authorized for any reason, the network operator would have the option of meeting user requests by sending them to alternate content providers/repositories, for similar or equivalent content delivery, and would therefore meet the limitations set forth in claims 14-18:

(Claim 14) *The method of claim 5, further comprising the step of determining if the content provider is authorized by a network operator to provide enhanced content programming to the user receiver.*

(Claim 15) *The method of claim 14, wherein said determining step is performed prior to said first intercepting step.*

(Claim 16) *The method of claim 14, wherein said determining step is performed prior to forwarding said user request response to the user receiver.*

(Claim 17) *The method of claim 14, further comprising the step of terminating the network transaction between the user receiver and the content provider if the content provider is unauthorized.*

(Claim 18) *The method of claim 14, further comprising the step of forwarding said appended user request to a substitute content provider if the content provider is 3 unauthorized.*

**As per claims 22-25:**

Ginter discloses all the limitations of claim 5.

Ginter does not specifically disclose the steps recited in claims 22-25, 30.

However Ginter teaches (Figs 1, 7-8, associated text; Col 33, line 66 – Col 35, line 12; Col 62-63, "Electronic Appliance") that his system will accommodate electronic "appliances" built from many different hardware configurations running many well-known operating and file systems, communicating seamlessly with each other over many different networks. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to build into a distribution network as taught by Ginter capabilities for determining the exact hardware/software capabilities of each user appliance, so that content may be properly formatted and therefore usable to the users. Such a system would comprise limitations meeting claims 22-25:

(Claim 22) *..wherein said additional parameters appended to said intercepted user request is comprised of a set of user receiver capabilities.*

(Claim 23) *..wherein said additional parameters appended to said intercepted user request is comprised of a network specification.*

(Claim 24) *.. wherein said additional parameters appended to said intercepted user request is comprised of a user receiver specification.*

(Claim 25) *.. wherein said additional parameters appended to said intercepted user request is comprised of network operator business rules.*

**As per claim 30:**

Ginter discloses all the limitations of claim 26.

Ginter does not specifically disclose the steps recited in claim 30.

However Ginter teaches (Figs 1, 7-8, associated text; Col 33, line 66 – Col 35, line 12; Col 62-63, "Electronic Appliance") that his system will accommodate electronic "appliances" built from many different

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hardware configurations running many well-known operating and file systems, communicating seamlessly with each other over many different networks. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to build into a distribution network as taught by Ginter capabilities for determining the exact display hardware/software capabilities of each user appliance, so that content may be properly formatted and therefore displayed to the users. Such a system would comprise limitations meeting claim 30:

*third party means for determining a set of display capabilities for said receiver, wherein said set of display capabilities is contained within said user profile; and*

*third party means for formatting said selected portion of said stored data  
and said supplemental information to correspond to said set of display capabilities*

7. **Claims 31-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ginter* and further in view of *Kitsukawa et al.*, US Patent No 6,282,713.

As per **claims 31-32**:

Ginter discloses all the limitations of claim 26.

Ginter does not specifically state that

(Claim 31) *..said displayed selected portion of said stored data and said supplemental information is a semi-transparent overlay.*

(Claim 32) *..said displayed selected portion of said stored data and said supplemental information utilizes only a portion of a screen corresponding to said display.*

Kitsukawa discloses a method and apparatus for providing electronic advertising wherein advertisements and product promotion information are overlaid on top of user-requested content such as television shows or movies (Abstract; Figs 5, 9, associated text). The displayed additional information is shown to occupy only a portion of a screen corresponding to the display of the user-requested content.

Ginter teaches that advertisements and promotional material may be appended to user-requested content utilizing the capabilities of his VDE network. Kitsukawa teaches that such advertisement may be displayed as overlays on top of running or streaming content. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined Ginter's and Kitsukawa's teachings to configure a content delivery method whereby stored and supplemental information would be semi-transparent overlays. These would be displayed on top of user-requested content, to deliver advertisements/promotions or user feedback response requests, such displays being timed and tied to the content being displayed, for better user response. Such a method would have met all the limitations of claims 31 and 32.

#### ***Prior Art***

8. Other references cited as potential prior art for this Application but not used in rejections are:

*Reilly et al.*, *Walker et al.*, *Fulton et al.*, and *Griffiths et al.*, US Patents Nos 5,740,549;

6,131,086; 6,182,052; and 6,286,045 respectively.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL  
December 16, 2002



**JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**